

Remarks

The Office Action mailed August 8, 2006 has been carefully reviewed and the foregoing amendments have been made in consequence thereof.

Claims 1-35 and 37-48 are pending in this application. Claims 1-11 and 20-32 stand rejected. Claims 12-19 and 33-47 have been withdrawn from consideration. Claim 36 has been cancelled. Claim 48 has been newly added. No new matter has been added.

In accordance with 37 C.F.R. 1.136(a), a three-month extension of time is submitted herewith to extend the due date of the response to the Office Action dated August 8, 2006, for the above-identified patent application from November 8, 2006, through and including February 8, 2007. In accordance with 37 C.F.R. 1.17(a)(3), authorization to charge a deposit account in the amount of \$1,020.00 to cover this extension of time request also is submitted herewith.

The rejection of Claims 1-11 and 20-32 under 35 U.S.C. § 103(a) as being unpatentable over Pope et al. (U.S. Pub. No. 2002/0178190) ("Pope") in view of Broadbent et al. (U.S. Pub. No. 2001/0047326) ("Broadbent") is respectfully traversed.

Applicants respectfully submit that neither Pope nor Broadbent, alone or in combination, describe or suggest the claimed invention. As discussed below, at least one of the differences between the cited references and the present invention is that neither Pope nor Broadbent, describe or suggest a document assembly production system that includes a server having a plurality of templates and other document assembly assets including a plurality of input documents stored therein, and at least one remote computer configured to communicate with the server, wherein the server is configured to prompt a user to select a template from the plurality of templates, wherein *each template is associated with a class of document to be assembled for a type of transaction* and *each document class includes a plurality of document types, wherein each document type represents specific contractual provisions typically associated with completing the corresponding transaction type*, and wherein each template includes logic for controlling a structure of the assembled document including logic that controls displaying

document structure questions and identifying input documents used for performing the document assembly. (Emphasis added.)

Notably, the Office Action asserts that Pope describes “each template is associated with a class of document to be assembled for a type of transaction” and “each document class includes a plurality of document types typically associated with the corresponding transaction type”. However, as discussed below, Pope actually describes a system for automatically generating correspondence documents that includes a web page having a document selection section for identifying a type of correspondence to be generated and an input variables section for identifying a subject of the correspondence. The Office Action appears to assert that the document selection section for identifying a type of correspondence described in Pope teaches both (1) a template associated with a class of document to be assembled for a type of transaction, and (2) a document class having a plurality of document types typically associated with the corresponding transaction type. Applicants traverse this assertion and submit that a single element described in Pope (i.e., document selection section for identifying a type of correspondence) cannot be relied upon for supposedly teaching two different elements of the present application (i.e., a class of document and a plurality of document types).

Applicants also submit that Pope does not describe or suggest *each document type represents specific contractual provisions typically associated with completing the corresponding transaction type*. Rather, Pope only describes a system for automatically generating correspondence documents. Pope does not describe, teach or even mention assembling documents having specific contractual provisions typically associated with completing a corresponding transaction.

Moreover, neither Pope nor Broadbent describe or suggest a document assembly production system that includes a server configured to display document structure questions on the remote computer wherein the document structure questions displayed are controlled by logic and conditions imbedded in the selected template and are displayed in a tree format and wherein *the document structure questions prompt the user to identify specific document types*

representing specific contractual provisions to be included in the assembled document for completing the transaction type, and receive a response for each document structure question displayed wherein the document structure responses determine the document types included within the assembled document. (Emphasis added.)

Notably, the Office Action asserts that Broadbent describes the above recitation. However, as discussed below, Broadbent describes a system used in the mortgage industry for generating and monitoring a set of required procedures involved in moving and tracking a mortgage loan including generating a set of required tasks for use in managing the mortgage loan process. Broadbent describes input screens for prompting a borrow to input data relating to a mortgage loan. These input screens, such as Figure 9, may include a list of questions. However, Applicants assert that Broadbent does not describe or teach a document assembly production system that includes a server configured to display document structure questions on a remote computer wherein the document structure questions displayed are controlled by logic and conditions imbedded in a selected template and wherein the document structure questions prompt the user to identify specific document types representing specific contractual provisions to be included in an assembled document for completing the transaction type, and receive a response for each document structure question displayed wherein the document structure responses determine the document types included within the assembled document.

Furthermore, neither Pope nor Broadbent, alone or in combination, describe or suggest a document assembly production system that includes a server configured to *identify pre-assigned, modifiable input documents from the plurality of input documents compatible with the selected template and the document structure responses for generating the documents to be assembled wherein the identified input documents including data fill-points*, and display transaction questions on the remote computer wherein *the transaction questions displayed are controlled by logic and conditions imbedded in the selected template and the document structure responses*.

Pope describes a web-based system that automatically integrates mainframe and client-server data into automatically generated business letters and other types of correspondence that

can be edited and then sent from a business enterprise to its customers. The data that can be automatically integrated into the generated correspondence includes customer-specific data, as well as data identifying the author of the letter. In addition, the system provides for the inclusion of the enterprise's logo and watermark and a graphical image of author's signature in the generated document, as well as automated faxing, e-mailing, and printing of the document.

More specifically, Pope describes a system that includes a personal computer operated by an employee of a business organization. In generating correspondence, the employee enters suitable inputs into a web page that is displayed on the computer monitor. These inputs include, for example, the desired style of the document to be generated, a description of the type of document to be generated, and information identifying the customer to whom the correspondence is to be addressed. Once the information has been entered into the web page, the back-end of the system generates the requested document in the form of a Microsoft Word document, which is displayed to the user. Depending upon the style selected by the user, this document may be on letterhead, may bear a watermark, and may also bear a graphical image of a signature. The user edits the document, if needed. Once the document is in final form, the user then provides an input to the system, causing the system to complete the processing of the document. The system may, at the user's option, email or fax the document to a designated recipient. Alternatively, the document may be printed out in hard copy form at a local or network printer for mailing to the addressee using conventional mail.

Broadbent describes a system used in the mortgage industry for combining a lender's Loan Application System with an automated Compliance Engine used for generating and monitoring a set of required procedures involved in moving and tracking a mortgage loan through one or more of the steps of `originate`, `approve`, `close`, `fund`, and `ship`. The system uses the Federal, State, local and professional regulations and requirements and implementing instructions to generate a plurality of tasks which can be used to control and drive the process of handling a mortgage loan application to completion and settlement in accordance with these regulations. Mortgage loan requestors may specify that the system will generate the plurality of required tasks, including tasks required by applicable federal or state law, provide the

plurality of required tasks to the requester for his execution, including tasks required by applicably federal or state law, and monitor the completion of all required tasks so as to provide a completion certificate to the requestor.

Claim 1 recites a document assembly production system that includes a server having a plurality of templates and other document assembly assets including a plurality of input documents stored therein, and includes at least one remote computer configured to communicate with the server directing the server to access the plurality of templates and the other assembly assets to assemble fully formatted documents without using any document-assembly software and word processing software stored on the at least one remote computer. The server is configured to: “prompt a user through the at least one remote computer to select a template from the plurality of templates, each template is associated with a class of document to be assembled for a type of transaction, wherein each document class includes a plurality of document types, each document type represents specific contractual provisions typically associated with completing the corresponding transaction type, each template includes logic for controlling a structure of the assembled document wherein the logic controls displaying document structure questions and identifying input documents used for performing the document assembly...display document structure questions on the remote computer, wherein the document structure questions displayed are controlled by logic and conditions imbedded in the selected template and are displayed in a tree format, the document structure questions prompt the user to identify specific document types representing specific contractual provisions to be included in the assembled document for completing the transaction type...receive a response for each document structure question displayed, wherein the document structure responses determine the document types included within the assembled document...identify pre-assigned, modifiable input documents from the plurality of input documents compatible with the selected template and the document structure responses for generating the documents to be assembled, the identified input documents including data fill-points...display transaction questions on the remote computer, wherein the transaction questions displayed are controlled by logic and conditions imbedded in the selected template and the document structure responses...receive a response for each transaction question

displayed, wherein the transaction responses populate the data fill-points included within the identified input documents...and generate the assembled document based on the identified input documents and the transaction responses received.”

Neither Pope nor Broadbent, considered alone or in combination, describe or suggest a document assembly production system as recited in Claim 1. More specifically, neither Pope nor Broadbent, alone or in combination, describe or suggest a server having a plurality of templates and other document assembly assets including a plurality of input documents stored therein, and at least one remote computer configured to communicate with the server, wherein the server is configured to prompt a user to select a template from the plurality of templates, wherein *each template is associated with a class of document to be assembled for a type of transaction and each document class includes a plurality of document types, wherein each document type represents specific contractual provisions typically associated with completing the corresponding transaction type*, and wherein each template includes logic for controlling a structure of the assembled document including logic that controls displaying document structure questions and identifying input documents used for performing the document assembly. (Emphasis added.)

The Office Action asserts at page 5 that Pope describes “each template is associated with a class of document to be assembled for a type of transaction” and “each document class includes a plurality of document types typically associated with the corresponding transaction type”. However, Pope actually describes a system for automatically generating correspondence documents that includes a web page having a document selection section for identifying a type of correspondence to be generated and an input variables section for identifying a subject of the correspondence. Specifically, Pope describes at paragraphs [0052-0055] in relevant part as follows:

The Fast Path box 208 is used when the user already knows the name of the type of correspondence to be generated. Typing the name into the Fast Path box 208 brings the user directly to the input variables screen for that document, shown in FIG. 7, discussed below.

Alternatively, if the user does not already know the name of the type of correspondence to be generated, the user clicks on the downward pointing arrow on the right side of the Batch box 210 and is presented with a drop-down box containing the document names and descriptions of all of the types of letters that the person logged in is allowed to access. Thus, the contents of the Batch drop-down box will vary, depending upon the identity of the user.

FIG. 6 shows a screenshot of the NOVA main page 200, in which the user has clicked on the downward pointing arrow at the right side of the Batch box 210. As shown in FIG. 6, clicking on the arrow causes a drop down box 216 to appear, which contains a list of documents accessible by the user....

As shown in FIG. 7, identifying the desired document type, either by using the Fast Path box 208 or the Batch box 210 causes the name and description of the document to appear in the Batch box 210....

In other words, it appears that Pope describes a system wherein a user selects a document type (i.e., type of correspondence) from a pull-down list of document types, and this selection causes the system to display an input variables screen so that the user can input certain data for completing the selected correspondence type.

The Office Action appears to assert that the document selection section for identifying the type of correspondence described in Pope teaches both (1) a template associated with a class of document to be assembled for a type of transaction, and (2) a document class having a plurality of document types typically associated with the corresponding transaction type. Applicants traverse this assertion and submit that a single element, such as the document selection section for identifying the type of correspondence described in Pope, cannot be relied upon for supposedly describing or suggesting both (1) a template associated with a class of document to be assembled for a type of transaction, and (2) a document class having a plurality of document types typically associated with the corresponding transaction type. Accordingly, Applicants submit that Pope does not describe or suggest at least a document class including a plurality of document types typically associated with completing the corresponding transaction type.

Applicants also submit that Pope does not describe or suggest *each document type represents specific contractual provisions typically associated with completing the*

corresponding transaction type. Rather, Pope only describes a system for automatically generating correspondence documents. Pope does not describe, teach or even mention assembling documents having specific contractual provisions typically associated with completing a corresponding transaction.

Moreover, neither Pope nor Broadbent describe or suggest a document assembly production system that includes a server configured to display document structure questions on the remote computer wherein the document structure questions displayed are controlled by logic and conditions imbedded in the selected template and are displayed in a tree format and wherein *the document structure questions prompt the user to identify specific document types representing specific contractual provisions to be included in the assembled document for completing the transaction type*, and receive a response for each document structure question displayed *wherein the document structure responses determine the document types included within the assembled document.* (Emphasis added.)

Notably, the Office Action asserts that Broadbent describes the above recitation. However, as discussed below, Broadbent describes a system used in the mortgage industry for generating and monitoring a set of required procedures involved in moving and tracking a mortgage loan including generating a set of required tasks for use in managing the mortgage loan process. Broadbent describes input screens for prompting a borrow to input data relating to a mortgage loan. These input screens, such as Figure 9, may include a list of questions. However, Applicants assert that Broadbent does not describe or teach a document assembly production system that includes a server configured to display document structure questions on a remote computer wherein the document structure questions displayed are controlled by logic and conditions imbedded in a selected template and are displayed in a tree format and wherein the document structure questions prompt the user to identify specific document types representing specific contractual provisions to be included in an assembled document for completing the transaction type, and receive a response for each document structure question displayed wherein the document structure responses determine the document types included within the assembled document.

Furthermore, neither Pope nor Broadbent, alone or in combination, describe or suggest a document assembly production system that includes a server configured to *identify pre-assigned, modifiable input documents from the plurality of input documents compatible with the selected template and the document structure responses for generating the documents to be assembled wherein the identified input documents including data fill-points*, and display transaction questions on the remote computer *wherein the transaction questions displayed are controlled by logic and conditions imbedded in the selected template and the document structure responses*. (Emphasis added.)

For at least the reasons set forth above, Applicants respectfully submit that Claim 1 is patentable over Pope in view of Broadbent.

Claims 2-11 depend from independent Claim 1. When the recitations of Claims 2-11 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2-11 likewise are patentable over Pope in view of Broadbent.

Claim 20 recites a document assembly production system that includes a server, a database coupled to the server for storing a plurality of templates and other document assembly assets including a plurality of input documents, and at least one remote computer in communication with the server. The server is configured to “prompt a user through said at least one remote computer to select a template from the plurality of templates, each template is associated with a class of document to be assembled for a type of transaction, wherein each document class includes a plurality of document types, each document type represents specific contractual provisions typically associated with completing the corresponding transaction type, each template includes logic for controlling a structure of the assembled document including logic for controlling displaying document structure questions and identifying input documents used for performing the document assembly...display document structure questions on said remote computer, wherein the document structure questions displayed are controlled by logic and conditions imbedded in the selected template and are displayed in a tree format...receive a response for each document structure question displayed, wherein the document structure

responses determine the document types included within the assembled document...identify pre-assigned, modifiable input documents from the plurality of input documents compatible with the selected template and the document structure responses for generating the documents to be assembled, the identified input documents including data fill-points...display transaction questions on the remote computer, wherein the transaction questions displayed are controlled by logic and conditions imbedded in the selected template and the document structure responses...receive a response for each transaction question displayed, wherein the transaction responses populate the data fill-points included within the identified input documents...and generate the assembled document based on the identified input documents and the transaction responses received."

Claim 20 recites a document assembly production system that includes a server configured to perform steps essentially similar to those steps performed by the server recited in Claim 1. Thus, it is submitted that Claim 20 is patentable over Pope in view of Broadbent for at least the reasons that correspond to those given with respect to Claim 1.

Claims 21-32 depend from independent Claim 20. When the recitations of Claims 21-32 are considered in combination with the recitations of Claim 20, Applicants submit that dependent Claims 21-32 likewise are patentable over Pope in view of Broadbent.

For at least the reasons set forth above, Applicants respectfully request that the rejection of Claims 1-11 and 20-32 under 35 U.S.C. § 103(a) be withdrawn.

In addition, Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. As is well established, obviousness cannot be established by merely suggesting that it would have been obvious to one of ordinary skill in the art to modify Pope using the teachings of Broadbent. More specifically, as is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.

Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

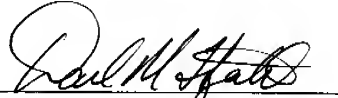
As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicant's disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion or motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

Neither Pope nor Broadbent, considered alone or in combination, describe or suggest the claimed combination. Rather, the present Section 103 rejection is based on a combination of teachings selected from multiple references in an attempt to arrive at the claimed invention. Because there is no teaching, suggestion, or motivation for the combination of Pope and Broadbent, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants requests that the Section 103 rejection of Claims 1-11 and 20-32 be withdrawn.

Newly added Claim 48 depends from independent Claim 1, which is submitted in condition for allowance and is patentable over the cited art. For at least the reasons set forth above, Applicants respectfully submit that Claim 48 is also patentable over the cited art.

In view of the foregoing amendments and remarks, all the Claims now active in the application are believed to be in condition for allowance. Favorable action is respectfully solicited.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Daniel M. Fitzgerald", written over a horizontal line.

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